

- Group VII: Claims 29-36, and 39-42, drawn to a method of prescreening for an agent where the prescreening involves detecting an EG-1 polypeptide;
- Group VIII: Claims 43-47, drawn to a transgenic animal comprising a recombinantly modified EG-1 gene that does not transcribe a functional EG-1 protein; and
- Group IX: Claims 49-54, drawn to a method of inhibiting angiogenesis by inhibiting the expression or activity of an EG-1 gene product.

In response to this restriction requirement, Applicants provisionally elect Group I, claims 1-7 and 11, with traverse.

Applicants submit that restriction between Groups I and II is unnecessary. According to MPEP §803, the Examiner should examine all claims in an application, even though they are directed to distinct inventions, unless to do so would create a serious burden. In the instant case, the claims of Groups I are drawn to an EG-1 nucleic acid, while the claims of Group II are drawn to a polypeptide encoded by an EG-1 nucleic acid. A search for prior art pertinent to the nucleic acid is expected to identify any prior art (if such exists) pertinent to the polypeptide encoded by that nucleic acid. Moreover it is noted that the nucleic acid and the encoded polypeptide can both be readily searched in the sequence databases **using only a single search.** Thus, a search for art relevant to Groups I and II together, entails no greater burden than a search for art relevant to Group I alone. Accordingly, Examination of Groups I and II together entails no serious burden and the restriction between these groups should be withdrawn.

Applicants further note that the restriction between Groups IV and V and between Groups VI and VII is legally improper. In making such a restriction, the Examiner effectively requires that a single claim (*e.g.*, claim 15, and claim 29,) be divided up and presented in several applications. This flatly contravenes accepted law. As stated by the CCPA:

As a general proposition, an applicant has a right to have *each claim* examined on the merits.

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If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be

defined by the examiner, rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

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§121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inventions. . . . It does not provide a basis under the authority of the Commissioner to *reject* a particular *claim* on that same basis.

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We hold that a rejection under §121 violates the basic right of the applicant to claim his invention as he chooses. *In Re Weber, Soder and Boksay* 198 USPQ 328, 331-332 (CCPA 1978)

See also, In Re Haas 179 USPQ 623, 624, 625 (*In Re Haas I*) and *In Re Haas* 198 USPQ 334-337 (*In Re Haas II*).

The CCPA thus recognized that an Examiner **may not** reject a particular claim on the basis that it represents "independent and distinct" inventions. *See, In re Weber Soder and Boksay, supra*. Moreover, **the CCPA recognized that imposition of a restriction requirement on a single claim is just such an improper rejection.**

In particular, the courts have definitively ruled that the statute authorizing restriction practice, *i.e.*, 35 U.S.C. §121, provides no legal authority to impose a restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions. *See, In Re Weber, Soder and Boksay, In Re Haas I, and In Re Haas II*. More specifically, the CCPA expressly ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Patent Office to fashion such a rejection. As noted in *Weber*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim-- **no matter how broad, which means no matter how many independently patentable inventions may fall within it.** [emphasis added] *In Re Weber* at 334.

Applicants recognize that instead of improperly imposing a restriction requirement on a single claim, the Office may limit initial examination to a "reasonable number" of species encompassed by the claim. *See, 37 C.F.R. §1.146*. This practice strikes an appropriate balance between the concerns of the patent office regarding administrative concerns and unduly burdensome

examination, and the clear constitutional and statutory rights of an inventor to claim an invention as it is contemplated, provided the dictates of 35 U.S.C. §112 are complied with. *See, e.g.,* the MPEP at 803.02, *In Re Wolfrum* 179 USPQ 620 (CCPA, 1973) and *In re Kuehl* 177 USPQ 250 (CCPA, 1973). Unlike a restriction requirement, a species election does not preclude an applicant from pursuing the original form of a claim in subsequent prosecution, nor does it force an applicant to file multiple divisional applications that are incapable of capturing the intended scope of the application.

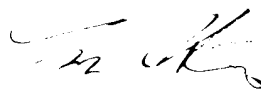
Finally, Applicants note that the CCPA has explicitly held that improper restriction of a single claim is a decision under the jurisdiction of the Board of Appeals, and the Federal Courts. This is in contrast to simple administrative decisions regarding ordinary restriction requirements, which are not generally subject to Appellate review. *See, In Re Haas I, supra.* Because restriction of a single claim into multiple groups is tantamount to a rejection and a refusal to examine the claim as drafted, as articulated in *Haas I*, the Board of Appeals and the courts have jurisdiction over the decision. Accordingly, **Applicants expressly reserve the right to appeal any decision that may be made regarding the present petition to the Patent Office Board of Appeals and to the Federal Circuit.**

In view of the foregoing, Applicants believe the restriction between Groups I and II, is unnecessary and the restriction between Groups IV and V and between Groups VI and VII is legally improper and these restrictions should be withdrawn.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 337-7871.

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Respectfully submitted,



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